

O-057-17

TRADE MARKS ACT 1994

**IN THE MATTER OF APPLICATION NO. 3118056
BY JOANNA BROWN AND LUCY TARRANT TO REGISTER THE TRADE MARK**



IN CLASSES 6, 25 AND 41

**AND IN THE MATTER OF OPPOSITION THERETO UNDER NO. 405420
BY AUTUMNPAPER LIMITED**

Background and pleadings

1) Joanna Brown and Lucy Tarrant (“the applicants”) applied to register the mark 3118056 in the UK on 16 July 2015. It was accepted and published in the Trade Marks Journal on 7 August 2015. The relevant details of this application are shown below:

<p>Mark:</p> 	<p>Class 6: <i>Key chains of precious metal; Key chains of common metal; Artistic castings of common metal; Artistic objects of common metal.</i></p> <p>Class 25: <i>Clothing, footwear, headgear.</i></p> <p>Class 41: ...</p>
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2) Autumnpaper Limited (“the opponent”) opposes the mark on the basis of section 5(2)(b), section 5(3) and section 5(4)(a) of the Trade Marks Act 1994 (“the Act”). The ground based upon section 5(2)(b) is based upon a claim the applicants’ mark is in respect of a mark similar to that of the opponent , and in respect of identical or similar goods and services. The opponent claims a reputation in respect of the same earlier marks and that, due to the similarity between them and the applicant’s mark, the relevant public would believe that they are used by the same undertaking. It also claims that use of the applicants’ mark would amount to the riding on the coat tails of the opponent’s mark, tarnish its reputation and dilute its distinctive character. In the interests of procedural economy, the opponent reduced its scope of opposition only to the applicants’ Class 6 and Class 25 goods. Further, it also reduced the number of earlier marks relied upon for both these grounds to the following two:

3098411	
<p>Mark:</p> <p>MCQ</p>	<p>Goods relied upon:</p> <p>Class 9: <i>goggles for sports</i></p>

Filing date: 10 March 2015

Date of entry in register:

10 July 2015

Class 14: *Precious metals, unwrought or semi-wrought; alloys of precious metal; semi-precious stones; precious stones; horological and other chronometric instruments; watches; clocks; jewellery and imitation jewellery; parts and fittings for all the aforesaid goods; alarm clocks; bracelets; brooches; necklaces; earrings; chains; tie clips; tie pins; charms; cufflinks; diamonds; diamond jewellery; pearls; pearl jewellery; jewellery made from precious stones; ornaments of precious metals; ornamental pins; cases for jewellery; cases for watches; key rings; medals; straps for wristwatches; watch chains; gemstones, pearls and precious metals and imitations thereof; time instruments; other articles of precious metals and precious stones, and imitations thereof namely Statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Coins and tokens, works of art of precious metal, key rings (trinkets or fobs); jewellery boxes and watch boxes; and parts and fittings of all the aforesaid goods, included in the class.*

Class 18: *Sports bags*

Class 25: *Clothing; footwear; headgear; boots; ready-made clothing; lace boots; shoes; heels; slippers; bath slippers; sandals; trainers; beach shoes; sports shoes; shoes for racing; boots for climbing; boots for sports; socks; hosiery; tights; hats; bandanas; caps (headwear); berets; scarves; gloves (clothing); mittens; belts (being articles of clothing); shirts; T-shirts; polo shirts; sports shirts; trousers; jeans; shorts; sports shorts; swimwear; bathing trunks; bathing suits; bikinis; underwear; lingerie; bodices (lingerie); bath robes; tracksuits; outerclothing; coats; jackets; parkas; ski jackets; waterproof clothing; waterproof and weatherproof jackets and coats; ski wear; beach wear; suits; jumpers and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands (clothing); wristbands; menswear; womenswear; childrenswear; underclothing; clothing for men, women, children and infants; slacks; skirts; wraps; jerseys; blouses; dresses; frocks; gowns; sleepwear; robes; sweatshirts; bibs; stockings; earmuffs; ties; tuxedos; vests; kilts; shawls; blazers; overalls; sleep masks; money belts; aprons; wedding dresses; wedding gowns;*

bridesmaid dresses; bridesmaid gowns; cuffs; boas; fur stoles; winter sportswear; running, walking, hiking, camping and cycling wear; hoods; dress handkerchiefs.

Class 35: *Retail services connected with the sale of ..., goggles for sports, ..., precious metals, ..., semi-precious stones, precious stones, horological and other chronometric instruments, watches, clocks, jewellery and imitation jewellery, parts and fittings for all the aforesaid goods, alarm clocks, bracelets, brooches, necklaces, earrings, chains, tie clips, tie pins, charms, cufflinks, diamonds, diamond jewellery, pearls, pearl jewellery, jewellery made from precious stones, ornaments of precious metals, ornamental pins, cases for jewellery, cases for watches, key rings, medals, straps for wristwatches, watch chains, gemstones, pearls and precious metals and imitations thereof, time instruments, Statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Coins and tokens, works of art of precious metal, key rings (trinkets or fobs), jewellery boxes and watch boxes, ..., sports bags, ..., clothing, footwear, headgear, boots, ready-made clothing, lace boots, shoes, heels, slippers, bath slippers, sandals, trainers, beach shoes, sports shoes, shoes for racing, boots for climbing, boots for sports, socks, hosiery, tights, hats, bandanas, caps (headwear), berets, scarves, gloves (clothing), mittens, belts (being articles of clothing), shirts, T-shirts, polo shirts, sports shirts, trousers, jeans, shorts, sports shorts, swimwear, bathing trunks, bathing suits, bikinis, underwear, lingerie, bodices (lingerie), bath robes, tracksuits, outerclothing, coats, jackets, parkas, ski jackets, waterproof clothing, waterproof and weatherproof jackets and coats, ski wear, beach wear, suits, jumpers and cardigans, knitwear, leggings, neckties, pyjamas, waistcoats, headbands (clothing), wristbands, menswear, womenswear, childrenswear, underclothing, clothing for men, women, children and infants, slacks, skirts, wraps, jerseys, blouses, dresses, frocks, gowns, sleepwear, robes, sweatshirts, bibs, stockings, earmuffs, ties, tuxedos, vests, kilts, shawls, blazers, overalls, sleep masks, money belts, aprons, wedding dresses, weddings gowns, bridesmaid dresses, bridesmaid gowns, cuffs, boas, fur stoles, winter sportswear, running, walking, hiking, camping and cycling wear, hoods, dress handkerchiefs; online retail services connected*

with the sale of ..., goggles for sports, ..., precious metals, unwrought or semi-wrought, alloys of precious metal, semi-precious stones, precious stones, horological and other chronometric instruments, watches, clocks, jewellery and imitation jewellery, parts and fittings for all the aforesaid goods, alarm clocks, bracelets, brooches, necklaces, earrings, chains, tie clips, tie pins, charms, cufflinks, diamonds, diamond jewellery, pearls, pearl jewellery, jewellery made from precious stones, ornaments of precious metals, ornamental pins, cases for jewellery, cases for watches, key rings, medals, straps for wristwatches, watch chains, gemstones, pearls and precious metals and imitations thereof, time instruments, Statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Coins and tokens, works of art of precious metal, key rings (trinkets or fobs), jewellery boxes and watch boxes, ..., sports bags, ..., clothing, footwear, headgear, boots, ready-made clothing, lace boots, shoes, heels, slippers, bath slippers, sandals, trainers, beach shoes, sports shoes, shoes for racing, boots for climbing, boots for sports, socks, hosiery, tights, hats, bandanas, caps (headwear), berets, scarves, gloves (clothing), mittens, belts (being articles of clothing), shirts, T-shirts, polo shirts, sports shirts, trousers, jeans, shorts, sports shorts, swimwear, bathing trunks, bathing suits, bikinis, underwear, lingerie, bodices (lingerie), bath robes, tracksuits, outerclothing, coats, jackets, parkas, ski jackets, waterproof clothing, waterproof and weatherproof jackets and coats, ski wear, beach wear, suits, jumpers and cardigans, knitwear, leggings, neckties, pyjamas, waistcoats, headbands (clothing), wristbands, menswear, womenswear, childrenswear, underclothing, clothing for men, women, children and infants, slacks, skirts, wraps, jerseys, blouses, dresses, frocks, gowns, sleepwear, robes, sweatshirts, bibs, stockings, earmuffs, ties, tuxedos, vests, kilts, shawls, blazers, overalls, sleep masks, money belts, aprons, wedding dresses, wedding gowns, bridesmaid dresses, bridesmaid gowns, cuffs, boas, fur stoles, winter sportswear, running, walking, hiking, camping and cycling wear, hoods, dress handkerchiefs; department store retail services connected with the sale of ... goggles for sports, ..., precious metals, unwrought or semi-wrought, alloys of precious metal, semi-precious stones, precious

	<p>stones, horological and other chronometric instruments, watches, clocks, jewellery and imitation jewellery, parts and fittings for all the aforesaid goods, alarm clocks, bracelets, brooches, necklaces, earrings, chains, tie clips, tie pins, charms, cufflinks, diamonds, diamond jewellery, pearls, pearl jewellery, jewellery made from precious stones, ornaments of precious metals, ornamental pins, cases for jewellery, cases for watches, key rings, medals, straps for wristwatches, watch chains, gemstones, pearls and precious metals and imitations thereof, time instruments, Statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Ornaments, made of or coated with precious or semi-precious metals or stones, or imitations thereof, Coins and tokens, works of art of precious metal, key rings (trinkets or fobs), jewellery boxes and watch boxes, ... sports bags..., clothing, footwear, headgear, boots, ready-made clothing, lace boots, shoes, heels, slippers, bath slippers, sandals, trainers, beach shoes, sports shoes, shoes for racing, boots for climbing, boots for sports, socks, hosiery, tights, hats, bandanas, caps (headwear), berets, scarves, gloves (clothing), mittens, belts (being articles of clothing), shirts, T-shirts, polo shirts, sports shirts, trousers, jeans, shorts, sports shorts, swimwear, bathing trunks, bathing suits, bikinis, underwear, lingerie, bodices (lingerie), bath robes, tracksuits, outerclothing, coats, jackets, parkas, ski jackets, waterproof clothing, waterproof and weatherproof jackets and coats, ski wear, beach wear, suits, jumpers and cardigans, knitwear, leggings, neckties, pyjamas, waistcoats, headbands (clothing), wristbands, menswear, womenswear, childrenswear, underclothing, clothing for men, women, children and infants, slacks, skirts, wraps, jerseys, blouses, dresses, frocks, gowns, sleepwear, robes, sweatshirts, bibs, stockings, earmuffs, ties, tuxedos, vests, kilts, shawls, blazers, overalls, sleep masks, money belts, aprons, wedding dresses, weddings gowns, bridesmaid dresses, bridesmaid gowns, cuffs, boas, fur stoles, winter sportswear, running, walking, hiking, camping and cycling wear, hoods, dress handkerchiefs.</p>
EUTM 7594633	
<p>Mark:</p> <p>MCQ</p>	<p>Goods relied upon:</p> <p>Class 14: Precious metals and their alloys and goods in precious metals or coated therewith; semi-precious and precious stones;</p>

Filing date: 11 February
2009

Date of entry in register:
15 March 2012

horological and other chronometric instruments; watches, clocks, jewellery and imitation jewellery; jewellery cases; parts and fittings for all the aforesaid goods.

Class 18: *sports bags*

Class 25: *Clothing, footwear, headgear; boots; shoes; slippers; sandals; trainers; socks and hosiery; hats; caps; berets; scarves; gloves; mittens; belts (being articles of clothing); shirts; T-shirts; polo shirts; sports shirts; trousers; jeans; shorts; sports shorts; swimwear; underwear; lingerie; tracksuits; articles of outerwear; coats; jackets; ski jackets; waterproof and weatherproof jackets and coats; ski wear; suits; jumpers and cardigans; knitwear; leggings; neckties; pyjamas; waistcoats; headbands and wristbands; menswear; womenswear; childrenswear; underclothing; clothing for men, women, children and infants; slacks; skirts; wraps; jerseys; blouses; dresses; sleepwear; robes; sweatshirts; bibs; stockings; earmuffs; ties; tuxedos; vests; kilts; shawls; blazers; headbands and wristbands; overalls.*

Class 35: *Retail services connected with the sale of ..., precious metals and their alloys and goods in precious metals or coated therewith, semi-precious and precious stones, horological and other chronometric instruments, watches, clocks, jewellery and imitation jewellery, sports bags, ..., jewellery cases, ..., clothing, footwear, headgear; boots; shoes, slippers, sandals, trainers, socks and hosiery, hats, caps, berets, scarves, gloves, mittens, belts (being articles of clothing), shirts, T-shirts, polo shirts, sports shirts, trousers, jeans, shorts, sports shorts, swimwear, underwear, lingerie, tracksuits, articles of outerwear, coats, jackets, ski jackets, waterproof and weatherproof jackets and coats, ski wear, suits, jumpers and cardigans, knitwear, leggings, neckties, pyjamas, waistcoats, headbands and wristbands, menswear, womenswear, childrenswear, underclothing, clothing for men, women, children and infants, slacks, skirts, wraps, jerseys, blouses, dresses, sleepwear, robes, sweatshirts, bibs, stockings, earmuffs, ties, tuxedos, vests, kilts, shawls, blazers, headbands and wristbands, overalls, ...; enabling customers to conveniently view and purchase those goods from a general merchandise retail store or from a general merchandise internet website or from a general merchandise catalogue by mail order or by means of*

	<i>telecommunications, advertising services, promotional services, information and advisory services all relating to the aforesaid services.</i>
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3) In respect of the claim under section 5(4)(a), the opponent relies upon two signs, the first of which corresponds to its MCQ mark, claiming first use in 2006 throughout the UK in respect of handbags, backpacks, wallets, purses, bags, umbrellas, clothing, footwear and headgear. The second sign (shown below) is relied upon in respect of the same list of goods and the same first use date:



4) The applicants filed a counterstatement denying the claims made and putting the opponent to proof of use of its earlier UK marks. However, the two earlier marks that the opponent now relies upon are not subject to proof of use because their filing date is less than 5 years before the publication of the applicants' mark. As a consequence of this, the opponent may rely upon the full list of goods and services listed in its earlier two marks.

5) Both sides filed evidence and both sides provided written submissions. Neither side requested a hearing and I make a decision after careful consideration of the papers.

6) The opponent was represented by Mishcon de Reya LLP. The applicants were unrepresented.

Opponent's evidence

7) This takes the form of a witness statement by Jonathan Akeroyd, director and Chief Executive Officer of the opponent. He provides a history of the opponent that can be summarised as follows:

- The opponent owns the international luxury fashion brand ALEXANDER McQUEEN that was launched in the UK in 1992 and is the name of one of the youngest designers to achieve the title of “British Designer of the Year” and won the accolade four times between 1996 and 2003;
- The first ALEXANDER McQUEEN store opened in London in 1999 followed by others around the world. These outlets sold products under the ALEXANDER McQUEEN brand;

8) Mr Akeroyd states that "ALEXANDER McQUEEN is recognised today as one of the world's most iconic luxury fashion brands", as demonstrated in April 2011 when the brand's creative director was chosen to design Catherine Middleton's wedding gown for her globally televised wedding to Prince William.

9) Mr Akeroyd also provides further information regarding the renown of the ALEXANDER McQUEEN brand, but I do not need to detail it here, other than to say that it provides further support to what I have already summarised, that the brand is indeed of some renown.

10) Mr Akeroyd states that the opponent also launched the MCQ brand in 2006 and is used to identify its "more informal, youthful collections". Between 2006 and 2011, the mark was used in the following form:



11) In 2011, the opponent adopted the following revised version of the mark (the “MC in a Q logo”):



12) For the Spring/Summer 2016, the product range has borne the updated mark as shown below:



13) Mr Akeroyd also states that in addition to use in the forms shown above, the opponent "also makes extensive use of the MCQ word mark". Since 2006 it has used the MCQ mark aurally continually and consistently in the course of trade. Mr Akeroyd identifies such use by store assistants, in the marketing and promotion of the brand by the opponent's in-house marketing team and its external marketing & advertising agencies. Mr Akeroyd states that, in his experience the mark is pronounced as "Mc-Q" or "M-C-Q".

14) Mr Akeroyd identifies the following products lines sold under the various MCQ marks:

- clothing, footwear, headgear including dresses, skirts, jackets, T-shirts, shirts, vests, jeans, leggings, jumpers, hoodies, overcoats, trousers, suits, cardigans, polo shirts, sweatpants, sweatshirts, blouses, belts, scarves, gloves, hats, shoes, sneakers and boots (examples of use in respect of such goods are provided at Exhibit JA-2).
- various leather goods including handbags, wallets, satchels, tote bags, bowling bags, clutches, purses, pouches, card holders, envelops, phone cases, computer tablet covers, laptop bags and weekend bags (examples of such use are shown at Exhibit JA-3);
- jewellery such as bracelets, rings, pendants and key rings (examples of such use are provided at Exhibit JA-4).

15) Mr Akeroyd states that, in respect of these products, the mark is usually placed in a central or prominent position, but also sometimes positioned on the interior of the products (examples are shown at Exhibit JA-5). Most of the examples shown in the evidence illustrate use of the "MC in a Q" logo appearing alone or with the name

ALEXANDER MCQUEEN. However, there is less frequent use also shown of McQ, in particular, in Exhibit JA-11 which consists of extracts from fashion publications dating from December 2011 onwards. In addition, there is also some use of the mark MCQ, namely:

- undated photographs of the mark appearing on the front of t-shirts at Exhibit JA-2, page 7 and 8;
- Exhibit JA-11, page 2: An article in *Attitude* magazine dated 1 April 2010 entitled “NEW MCQ”;
- Exhibit JA-11, page 3: An article entitled “Reimagining Alexander McQueen for a New Generation” in *Dazed & Confused* magazine dated 1 August 2011 where MCQ appears prominently at the top of the page;
- Exhibit JA-11, page 4: An article in *Attitude* magazine dated 1 December 2011, where MCQ appears prominently at the top of the article;
- Exhibit JA-11, page 7: A photograph of a female model that appeared in *Dazed & Confused* magazine on 1 March 2012. Ineligible text appears below the photograph, but the mark MCQ can be seen above this text;
- Exhibit JA-11, page 8: The “News” page of “10” magazine, also dated 1 March 2012 includes a paragraph entitled “SEE FOR YOURSELF: MCQ”;
- Exhibit JA-11, page 9: a page entitled “LFW Report” that appeared in *Look* magazine on 6 March 2012. One of two headings that appears on the page is “MCQ”, but it is not possible to read the text that appears underneath;
- Exhibit JA-11, page 11: an article that appeared in *Dazed & Confused* magazine on 1 August 2012 includes the following introduction: The MCQ army returned to London this season with a show that was part Blair Witch and part Babes in the Wood...”;
- Exhibit JA-11, page 24: *The Sunday Times Style* magazine of 26 January 2014 carries a photograph of a model wearing a t-shirt decorated with the letters MCQ;
- Exhibit JA-11, page 28: a page from *GQ Style* magazine, dated 1 April 2014, shows a number of clothing items featuring prominent logos. One of these is a hoodie with MCQ appearing in large letters on the chest;

- Exhibit JA-11, page 33: an article that appeared in *Rollarcoaster* magazine on 1 September 2014. “MCQ Alexander McQueen FW14” is credited with providing all clothing shown in the article;
- Exhibit JA-11, page 8: a photograph that appeared in *Rollarcoaster* magazine on 1 February 2015 where a knitted jumper is shown that is credited as being “by MCQ ALEXANDER MCQUEEN”;
- Exhibit JA-11, page 55: An article about sweatshirts includes a photograph of one identified as “MCQ Alexander McQueen” that appeared in *The Observer* magazine on 17 May 2015.

16) At Exhibit 14 is an extract from the opponent’s Facebook page where it identifies itself as “MCQ Alexander Mcqueen”.

17) Mr Akeroyd states that MCQ branded goods are sold from an MCQ stand-alone store in London that opened in September 2012. One other London store has also subsequently opened.

18) Mr Akeroyd also states that MCQ branded products are also available for sale online from the opponent's website www.mcq.com/gb.

19) In addition, MCQ branded products are available through a network of authorised third party retailers including Harvey Nichols, Harrods and Selfridges. In these stores, Mr Akeroyd states, MCQ branded products are often sold from a space dedicated to providing retail services related to the brand with prominent signage displaying the marks (as shown in the photographs of concessions in *Selfridges* and *Harvey Nichols* provided at Exhibit JA-9).

20) Mr Akeroyd also states that MCQ branded products are sold through third party online shopping portals. Those identified by Mr Akeroyd are:
www.harveynichols.com, www.liberty.co.uk, www.harrods.com and www.selfridges.com.

21) Mr Akeroyd states that sales of products bearing the MCQ marks in the UK increased from over €5 million in 2012 and over €7 million in 2014.

22) At Exhibit JA-10, Mr Akeroyd provides examples of use and promotion in the UK. All except one (*Dazed and Confused*, March 2012) are in respect of the “MC in a Q” and includes numerous print advertisements including in the following publications: *Love* (March 2010), *Wonderland* (April 2011), *Elle* (April 2012 and April 2014), *GQ Style* (April 2012), *Grazia* (February 2013 and March 2015) and *The Sunday Times Style* (September 2013).

23) Mr Akeroyd also refers to the MCQ brand being awarded the Contemporary Brand of the Year 2013 in the *Elle Style Awards*. He also provides information regarding the MCQ brand's presence on social media such as *Facebook*, *Twitter* and *Instagram*.

Applicants' evidence

24) This takes the form of a witness statement by Fay Kelly, Co-Founder and Co-Director of UK Mudd Queens Ltd. Ms Kelly refers to the company as “the applicant” despite the recorded applicants being Joanna Brown and Lucy Tarrant. No issue has been made of this by the opponent and I take it that the company utilises the applicants' mark whilst undertaking its activities to “positively encourage and support women to take part in sporting activities, namely Obstacle Course Racing”.

25) Ms Kelly provides evidence that use of the applicants' mark pre-dates the filing date of the opponent's mark. She states that it was first used in December 2014 at an obstacle course race in Bagshot. I may not need to detail this because whilst such use may predate the filing date of the earlier UK registration, it is later than the filing date of the opponent's earlier European Union trade mark (“EUTM”) that is also valid in the UK. Therefore, a claim to concurrent use will only be relevant where the opponent's reliance upon its earlier UK mark provides it with a stronger case than its EUTM. It will become evident from my comments on the similarity of the parties' goods that this is not the case. Therefore, I will not detail this evidence.

DECISION

Section 5(2)(b)

26) Sections 5(2)(b) of the Act is as follows:

“5(2) A trade mark shall not be registered if because-

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected, or there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”.

Comparison of goods and services

27) In the judgment of the Court of Justice of the European Union (“the CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary”.

28) The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

- a) The respective users of the respective goods or services;
- b) The physical nature of the goods or acts of services
- c) The respective trade channels through which the goods or services reach the market

- d) In the case of self serve consumer items, where in practice they are respectively found or likely to be found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;
- e) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

29) I also keep in mind the following guidance of the General Court (“the GC”) in *Gérard Meric v Office for Harmonisation in the Internal Market (MERIC)*, Case T-133/05:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut für Lernsysteme v OHIM- Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark application are included in a more general category designated by the earlier mark”.

Class 6

30) The applicants’ specification includes the two terms *Key chains of precious metal* and *Key chains of common metal*. The first of these two terms describes goods that are proper to Class 14 and not Class 6 (see the WIPO Nice Classification at http://web2.wipo.int/classifications/nice/nicepub/en/fr/edition-20170101/search/results/?pagination=no&lang=en&mode=flat&explanatory_notes=show&basic_numbers=show&q=key&info_files=&op=OR&exact_search=&classes=6&classes=14). With this in mind, it is self-evident that the applicants’ *key chains of precious metal* are covered by the opponent’s *goods in precious metals* listed in the Class 14 specification of its earlier EUTM. Further, it is also covered by the term

chains in the Class 14 specification of the opponent's earlier UK mark. Taking account of the guidance provided in *MERIC*, these goods are identical.

31) In respect of the second term, namely, *Key chains of common metal*, the same of the opponent's goods as referred to in the previous paragraph include goods that are identical except that they are made of precious metals. Consequently, they share the same nature, intended purpose, methods of use, trade channels and are in competition with each other (in that a consumer may wish to make a choice between a key chain of common metal or of precious metal). The respective goods therefore share a very high level of similarity.

32) In respect of the applicants' *Artistic castings of common metal* and *Artistic objects of common metal*, the same goods, but made from precious metal or coated therewith are included in the opponent's *goods in precious metals or coated therewith* in the Class 14 specification of its earlier EUTM and for analogous reasons to those expressed above, I find that they share a very high level of similarity. Artistic castings may be used as ornaments or in the form of statues and, consequently, there is also a high level of similarity to the opponent's *ornaments made of precious metal* and *Statues and figurines, made of or coated with precious or semi-precious metals or stones, or imitations thereof* listed in its UK mark.

Class 25

33) Both of the opponent's earlier marks include the terms *clothing, footwear* and *headgear* in their Class 25 specifications. The applicants' Class 25 specification consists of the same terms and are, therefore, self-evidently identical.

34) It is clear from the above that when considering similarity of the respective goods, the opponent's UK mark does not place it in any stronger position than when relying on its EUTM.

Comparison of marks

35) The respective marks are:

Opponent's mark	Applicants' marks
MCQ	

36) It is clear from the judgment of CJEU in *Sabel BV v Puma AG*, Case C-251/95 (particularly paragraph 23) that the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the marks must be assessed by reference to the overall impressions created by the marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgment in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion.”

37) It would be wrong, therefore, to artificially dissect the trade marks, although, it is necessary to take into account the distinctive and dominant components of the marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the marks.

38) The opponent's mark consists of the three letters MCQ. No one letter stands out with no one letter being more dominant than any other. The consumer will not attempt to dissect the mark and its distinctiveness lies solely in the equal contribution that each letter makes to the mark. The applicants' mark consists of a number of distinct parts. Firstly, there is the crown device appearing at the top of the mark, the

letters UK appearing in the middle and the letters MQ at the bottom. In addition, these elements appear in the colour gold with a black but these colours play a less dominant role than the other elements of the mark that have roughly equal dominance. The letters UK are likely to be understood as being a reference to the United Kingdom and, as such, will contribute less to the distinctive character of the mark as a whole. The remaining elements contribute equally to the distinctive character of the mark with neither one dominating.

39) Visually, the respective marks share some similarity because they both share the letters M and Q. However, they differ in that the opponent's mark has the letter C appearing between the letters M and Q and because the applicants' mark has a number of additional elements, namely, a crown device, the letters UK and the colours gold and black. The opponent submits that there is a high level of visual similarity claiming that the crown device and the letters UK are non-distinctive. It also claims that a verbal component of a mark has a stronger impact than figurative components. In support of these submissions it cites a decision of the GC, namely, *Selenium-Ace*, T-312/03, paragraph 37 as well as a number of decisions of the EUIPO's boards of appeal. I am not bound by the latter. With regard to the GC's comments in *Selenium-Ace*, the GC observed that in a verbal and figurative mark "...the former should, in principle, be considered more distinctive than the latter, because the average consumer will more easily refer to the goods ... by quoting their name than describing the figurative element...". I do not take issue with this principle, but its application is to the aural considerations rather than visual, and I take it into account when making my comments in the next paragraph regarding aural similarity. Taking all of the above into account, I do not agree with the opponent and I conclude that the respective marks share only a low level of visual similarity.

40) Aurally, the opponent's mark is likely to be articulated as M-C-Q. I note that the Mr Akeroyd has stated that "[i]n [his] experience the word "MCQ" is pronounced "Mc-Q" or "M-C-Q". He provides no supporting evidence that it will be referred to as the former and I have some difficulty in accepting that the average UK consumer of *clothing and goods in precious metal* will perceive the mark as "Mc-Q". Of course customers of the opponent who will know that the mark is an off-shoot of the ALEXANDER MCQUEEN brand may perceive it otherwise, but these customers are

not the average consumer for the purposes of section 5(2)(b). Rather, I must consider the average consumer as a typical member of the UK clothes purchasing public (see paragraph 42, below). In summary, I reject the opponent's evidence insofar as it purports that its mark is articulated as Mc-Q. The applicants' mark will only be referred to by way of the letter elements and is likely to be articulated as the individual letters U-K-M-Q. I believe such a finding is consistent with the principle referred to by the GC in *Selenium-Ace*. There is some similarity between the marks because two of the four letters articulated in the applicants' mark are the same as two of the three letters articulated in the opponent's mark. That said, there is an equal number of aural elements that are different. Taking all of this into account, I conclude that the respective marks share a low to medium level of aural similarity.

41) The opponent's mark has no obvious conceptual meaning. The applicants' mark contains several elements where a concept can be identified. There is the crown device and the letters UK. The opponent submits that when seen with the letters MQ, the former will be perceived as a reference to McQUEEN. I disagree. Firstly, the letters MQ do not convey any obvious meaning, either as a reference to the name McQUEEN or to anything else. It is my view that the crown device will convey the concept of a crown, royalty or possibly quality. As I have already observed, the letters UK are likely to be perceived as a reference to the United Kingdom. In summary, I disagree with the opponent and conclude that there is no conceptual similarity between the marks.

Average consumer and the purchasing act

42) The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question: *Lloyd Schuhfabrik Meyer*, Case C-342/97.

43) In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

44) Firstly, Mr Akeroyd has made a number of submissions regarding how the opponent’s mark will be perceived. Whilst I have acknowledged earlier that consumers of ALEXANDER MCQUEEN branded products may perceive the earlier mark as “Mc-Q” rather than the more obvious M-C-Q, these are not the average consumer. Rather, the average consumer here is a member of the UK general public. In respect of the parties’ Class 6 and Class 9 goods, these are goods that vary greatly in cost, but regardless of this are normally bought by eye because much of their appeal is aesthetic, but I do not ignore aural considerations. Consequently, the level of attention paid during the purchasing process will be at least reasonable, but as the cost increases, so is it likely that the level of care and attention will rise. The one exception to this is *key chains of common metal* that are likely to be bought for more pragmatic reasons rather than because of aesthetics. As such, the purchasing process is likely to involve no more than a reasonable level of care and attention.

45) In respect of the parties’ Class 25 goods, the average consumer will be ordinary members of the public who wish to purchase clothing, footwear and headgear. The purchase is normally made from high street or Internet retailers. In respect of the nature of the purchasing act for these goods, I am mindful of the comments of Mr Simon Thorley, sitting as the Appointed Person, in *React trade mark* [2000] R.P.C. 285:

“There is no evidence to support Ms Clark’s submission that, in the absence of any particular reputation, consumers select clothes by eye rather than by placing orders by word of mouth. Nevertheless, my own experience tells me it

is true of most casual shopping. I have not overlooked the fact that catalogues and telephone orders play a significant role in this trade, but in my experience the initial selection of goods is still made by eye and subsequent order usually placed primarily by reference to a catalogue number. I am therefore prepared to accept that a majority of the public rely primarily on visual means to identify the trade origin of clothing, although I would not go so far as to say that aural means of identification are not relied upon.”

46) The GC has continued to identify the importance of visual comparison when considering the purchasing act in respect of clothing (see for example Joined Cases T-117/03 to T-119/03 and T-171/03 *New Look Ltd v OHIM (NLSPORT et al)* [2004] ECR II-3471 at [49]-[50] and Case T-414/05 *NHL Enterprises BV v OHIM (LA KINGS)* [2009] ECR II.). There is nothing before me in the current proceedings to lead me to conclude differently and, consequently, taking into account the above comments, I conclude that the purchasing act will generally be a visual one. However, I do not ignore the aural considerations that may be involved. The purchase of clothing and similar goods is, if not quite an everyday purchase, certainly a regular purchase for most consumers. Whilst these goods vary in cost, they are not normally very expensive. Taking account of this, the level of attention paid by the consumer is reasonable rather than high.

Distinctive character of the earlier trade mark

47) In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

48) The opponent's mark consists of the letters MCQ. I have already observed that these letters have no obvious meaning in the minds of the average consumer. Consequently, the mark will be perceived merely as a random collection of three letters and, as such, it has a reasonable level of inherent distinctive character, neither the highest nor lowest.

49) The opponent submits that's its mark has acquired “a very substantial reputation”. The use shown is in respect of three marks (see paragraphs 10, 11 and 12, above) that differ in their distinctive character from the registered mark. The first two of these present as the letters MC placed inside a large letter Q. In the first, the words ALEXANDER MCQUEEN also appear and this leads the average consumer to perceive the Q and MC elements as combining in a way to link to the full name and be seen as Mc-Q. This is different to the distinctive character of the earlier mark that creates no such link to the name and will merely be seen as the three random letters MCQ. As a result, I conclude that this use fails to demonstrate that the mark, MCQ, has acquired an enhanced level of distinctive character.

50) In the second, the words ALEXANDER MCQUEEN is absent and therefore, there is no obvious prompt for the average consumer to perceive the mark as McQ. Neither is it obvious that the MC element will be perceived as coming before the Q element. Therefore, the mark may equally be perceived as a QMC or a MCQ mark. Therefore, the visual impact is such that the distinctive character is different to that of

the registered mark MCQ, and I conclude any use of this mark fails to assist in the registered mark acquiring any enhanced distinctive character.

51) In respect of the third mark, the letter element clearly consists of McQ and will be perceived as an allusion to a surname consisting Mc and consequently its distinctive character is different to the random letters MCQ that, as I have already found, creates no such allusion to a surname.

52) The opponent does also rely on aural use by sales assistants and external marketing agencies. Such aural use does not necessarily contribute to use of the registered mark because it could merely be a reference to one of the three stylised marks referred to above. However, there is also evidence that the opponent does use MCQ either alone on its clothing or when referring to its clothing. Further, there is evidence of third parties identifying the opponent's goods by reference to "MCQ". Some of this use is in conjunction with "Alexander McQueen", but this does not distract from MCQ acting independently. This use is shown in Exhibits JA-11 and JA-14 (see paragraphs 14 and 15, above). Such use lends support to the claim of enhanced distinctive character. It is further supported by a statement that turnover in respect of MCQ branded clothing was over €5 million in 2012 and €7 million in 2014 and by the fact that in 2013 it was awarded "contemporary brand of the year" at the Elle Style Awards.

53) Taking account of all of the above, I find that the evidence demonstrates that the opponent's MCQ mark benefits from some enhanced level of distinctive character through use.

GLOBAL ASSESSMENT – Conclusions on Likelihood of Confusion.

54) The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.*, Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson*

Multimedia Sales Germany & Austria GmbH, Case C-120/04, Shaker di L. Laudato & C. Sas v OHIM, Case C-334/05P and Bimbo SA v OHIM, Case C-591/12P:

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.

55) I must adopt the global approach advocated by case law and take into account that marks are rarely recalled perfectly with the consumer relying instead on the imperfect picture of them he has in kept in his mind (*Lloyd Schuhfabrik Meyer & Co. GmbH v. Klijsen Handel B.V* paragraph 27). I must take into account all factors relevant to the circumstances of the case and, as the opponent has rightly pointed out, in particular the interdependence between the similarity of the marks and that of the goods or services designated (*Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*).

56) The opponent, in its written submissions, identifies a number of examples of cases decided before the EUIPO where a likelihood of confusion was found between various two letter marks and three letter marks that incorporate the two letters from the two letter mark. It suggests that this leads to a conclusion that a likelihood of confusion exists in the current proceedings. I have considered these cases, but none appear to be on all fours with the current case. The first is in respect of the two marks QT and QOT. Unlike in the current case, neither has any figurative element to factor in. The second is in respect of the marks  and CCB. Whilst, the first mark is stylised, neither mark has any additional elements to factor in, unlike in the current case. Finally, the third is in respect of the marks KfW and KW. Here the

presentation of the letter “f” in lower case can be argued as highlighting the letters K and W, being the same letters as in the second mark. No such visual prompt exists in the current case and further, there are additional elements that need to be borne in mind when considering the applicants’ mark. For these reasons, I do not find these earlier cases persuasive.

57) I have found that the respective marks share a low level of visual similarity, a medium level of aural similarity and no conceptual similarity. I have also found that the average consumer is a member of the general public and that the purchasing process is essentially visual in nature. Further, I found that the opponent’s mark is endowed with a reasonable level of distinctive character and that this is enhanced to some degree by the use made of it. Factoring all of these together, I find that despite many of the respective goods being identical, there is no likelihood of confusion. When the visual differences are considered together with the visual nature of the purchasing process, I find that the differences between the marks are such that the average consumer is not likely to assume that goods provided under the respective marks originate from the same or linked undertaking.

58) The opposition, insofar as it is based upon section 5(2)(b), fails in its entirety.

Section 5(4)(a)

59) Section 5(4)(a) states:

“A trade mark shall not be registered if, or to the extent that, its use in the United Kingdom is liable to be prevented –

(a) by virtue of any rule of law (in particular, the law of passing off) protecting an unregistered trade mark or other sign used in the course of trade, or

(b) [.....]

A person thus entitled to prevent the use of a trade mark is referred to in this Act as the proprietor of “an earlier right” in relation to the trade mark.”

Goodwill

60) In *Advanced Perimeter Systems Limited v Multisys Computers Limited*, BL O-410-11, Mr Daniel Alexander QC as the Appointed Person considered the relevant date for the purposes of Section 5(4)(a) of the Act and concluded as follows:

“39. In *Last Minute*, the General Court....said:

‘50. First, there was goodwill or reputation attached to the services offered by LMN in the mind of the relevant public by association with their get-up. In an action for passing off, that reputation must be established at the date on which the defendant began to offer his goods or services (*Cadbury Schweppes v Pub Squash* (1981) R.P.C. 429).

51. However, according to Article 8(4) of Regulation No 40/94 the relevant date is not that date, but the date on which the application for a Community trade mark was filed, since it requires that an applicant seeking a declaration of invalidity has acquired rights over its non-registered national mark before the date of filing, in this case 11 March 2000.’

61) Therefore, the relevant date for the purposes of this opposition is the filing date of the application, namely 16 July 2015. Whilst other dates may be relevant, such as the applicants’ claim to their first use in December 2014.

62) Guidance on the meaning of goodwill was provided in *Inland Revenue Commissioners v Muller & Co’s Margarine Ltd* [1901] AC 217 (HOL), where it was stated:

“What is goodwill? It is a thing very easy to describe, very difficult to define. It is the benefit and advantage of the good name, reputation and connection of

a business. It is the attractive force which brings in custom. It is the one thing which distinguishes an old-established business from a new business at its first start.”

63) In *South Cone Incorporated v Jack Bessant, Dominic Greensmith, Kenwyn House and Gary Stringer (a partnership)* [2002] RPC 19 (HC), Pumfrey J. stated:

“27. There is one major problem in assessing a passing of claim on paper, as will normally happen in the Registry. This is the cogency of the evidence of reputation and its extent. It seems to me that in any case in which this ground of opposition is raised the registrar is entitled to be presented with evidence which at least raises a prima facie case that the opponent's reputation extends to the goods comprised in the applicant's specification of goods. The requirements of the objection itself are considerably more stringent than the enquiry under s.11 of the 1938 Act (see *Smith Hayden & Co. Ltd's Application (OVAX)* (1946) 63 R.P.C. 97 as qualified by *BALI Trade Mark [1969] R.P.C. 472*). Thus the evidence will include evidence from the trade as to reputation; evidence as to the manner in which the goods are traded or the services supplied; and so on.

28. Evidence of reputation comes primarily from the trade and the public, and will be supported by evidence of the extent of use. To be useful, the evidence must be directed to the relevant date. Once raised, the applicant must rebut the prima facie case. Obviously, he does not need to show that passing off will not occur, but he must produce sufficient cogent evidence to satisfy the hearing officer that it is not shown on the balance of probabilities that passing off will occur.”

64) However, in *Minimax GmbH & Co KG v Chubb Fire Limited* [2008] EWHC 1960 (Pat), Floyd J. (as he then was) stated that:

“[The above] observations are obviously intended as helpful guidelines as to the way in which a person relying on section 5(4)(a) can raise a case to be answered of passing off. I do not understand Pumfrey J to be laying down any

absolute requirements as to the nature of evidence which needs to be filed in every case. The essential is that the evidence should show, at least prima facie, that the opponent's reputation extends to the goods comprised in the application in the applicant's specification of goods. It must also do so as of the relevant date, which is, at least in the first instance, the date of application.”

65) The opponent claims that its goodwill is identified by the sign MCQ and the following sign:



66) When considering the opponent's evidence when looking at the opponent's grounds based upon section 5(2)(b), I have identified use of its MCQ mark that is such that I found it benefited with some enhanced distinctive character, at least in respect of clothing. Consistent with such a finding I also find that the use is sufficient for me to conclude that the opponent's goodwill is identified by a number of marks including MCQ.

67) As the opponent's best case lies with its MCQ sign, I will consider the issue of misrepresentation from the perspective of this earlier sign.

Misrepresentation and damage

68) In *Neutrogena Corporation and Another v Golden Limited and Another* [1996] RPC 473, Morritt L.J. stated that:

“There is no dispute as to what the correct legal principle is. As stated by *Lord Oliver of Aylmerton in Reckitt & Colman Products Ltd. v. Borden Inc.* [1990] *R.P.C.* 341 at page 407 the question on the issue of deception or confusion is

“is it, on a balance of probabilities, likely that, if the appellants are not restrained as they have been, a substantial number of members of the public will be misled into purchasing the defendants' [product] in the belief that it is the respondents'[product]”

The same proposition is stated in Halsbury's Laws of England 4th Edition Vol.48 para 148 . The necessity for a substantial number is brought out also in *Saville Perfumery Ltd. v. June Perfect Ltd.* (1941) 58 R.P.C. 147 at page 175 ; and *Re Smith Hayden's Application* (1945) 63 R.P.C. 97 at page 101.”

And later in the same judgment:

“... for my part, I think that references, in this context, to “more than *de minimis*” and “above a trivial level” are best avoided notwithstanding this court's reference to the former in *University of London v. American University of London* (unreported 12 November 1993) . It seems to me that such expressions are open to misinterpretation for they do not necessarily connote the opposite of substantial and their use may be thought to reverse the proper emphasis and concentrate on the quantitative to the exclusion of the qualitative aspect of confusion.”

69) I recognise that the test for misrepresentation is different to that for likelihood of confusion, namely, that misrepresentation requires “a substantial number of members of the public are deceived” rather than whether the “average consumer are confused”. However, as recognised by Lewinson L.J. in *Marks and Spencer PLC v Interflora*, [2012] EWCA (Civ) 1501, it is doubtful whether the difference between the legal tests will produce different outcomes. Certainly, I believe that this is the case here. I find that the differences between the applicants’ mark and the opponent’s sign are such that members of the public will not be misled into purchasing the applicants’ goods in the belief that they are the opponent’s goods.

70) In light of this finding, it is not necessary for me to consider the position at the date of the applicants’ claimed first use in December 2014.

71) In the absence of misrepresentation, there can be no damage and I conclude that the opposition, insofar as it relies upon section 5(4)(a) fails in its entirety.

Section 5(3)

72) Section 5(3) states:

“(3) A trade mark which-
(a) is identical with or similar to an earlier trade mark, shall not be registered if, or to the extent that, the earlier trade mark has a reputation in the United Kingdom (or, in the case of a European Union trade mark or international trade mark (EC), in the European Union) and the use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trade mark.”

73) The relevant case law can be found in the following judgments of the CJEU: Case C-375/97, *General Motors*, [1999] ETMR 950, Case 252/07, *Intel*, [2009] ETMR 13, Case C-408/01, *Addidas-Salomon*, [2004] ETMR 10 and C-487/07, *L’Oreal v Bellure* [2009] ETMR 55 and Case C-323/09, *Marks and Spencer v Interflora*. The law appears to be as follows.

a) The reputation of a trade mark must be established in relation to the relevant section of the public as regards the goods or services for which the mark is registered; *General Motors*, paragraph 24.

(b) The trade mark for which protection is sought must be known by a significant part of that relevant public; *General Motors*, paragraph 26.

(c) It is necessary for the public when confronted with the later mark to make a link with the earlier reputed mark, which is the case where the public calls the earlier mark to mind; *Adidas Saloman*, paragraph 29 and *Intel*, paragraph 63.

(d) Whether such a link exists must be assessed globally taking account of all relevant factors, including the degree of similarity between the respective marks and between the goods/services, the extent of the overlap between the

relevant consumers for those goods/services, and the strength of the earlier mark's reputation and distinctiveness; *Intel, paragraph 42*

(e) Where a link is established, the owner of the earlier mark must also establish the existence of one or more of the types of injury set out in the section, or there is a serious likelihood that such an injury will occur in the future; *Intel, paragraph 68*; whether this is the case must also be assessed globally, taking account of all relevant factors; *Intel, paragraph 79*.

(f) Detriment to the distinctive character of the earlier mark occurs when the mark's ability to identify the goods/services for which it is registered is weakened as a result of the use of the later mark, and requires evidence of a change in the economic behaviour of the average consumer of the goods/services for which the earlier mark is registered, or a serious risk that this will happen in future; *Intel, paragraphs 76 and 77*.

(g) The more unique the earlier mark appears, the greater the likelihood that the use of a later identical or similar mark will be detrimental to its distinctive character; *Intel, paragraph 74*.

(h) Detriment to the reputation of the earlier mark is caused when goods or services for which the later mark is used may be perceived by the public in such a way that the power of attraction of the earlier mark is reduced, and occurs particularly where the goods or services offered under the later mark have a characteristic or quality which is liable to have a negative impact of the earlier mark; *L'Oreal v Bellure NV, paragraph 40*.

(i) The advantage arising from the use by a third party of a sign similar to a mark with a reputation is an unfair advantage where it seeks to ride on the coat-tails of the senior mark in order to benefit from the power of attraction, the reputation and the prestige of that mark and to exploit, without paying any financial compensation, the marketing effort expended by the proprietor of the mark in order to create and maintain the mark's image. This covers, in particular, cases where, by reason of a transfer of the image of the mark or of

the characteristics which it projects to the goods identified by the identical or similar sign, there is clear exploitation on the coat-tails of the mark with a reputation (*Marks and Spencer v Interflora*, paragraph 74 and the court's answer to question 1 in *L'Oreal v Bellure*).

74) For the purposes of my analysis, I assume that the mark MCQ has acquired a strong reputation. It is well established that the level of similarity required for the public to make a link between the marks for the purposes of 5(3) may be less than the level of similarity required to create a likelihood of confusion (see *Intra-Press SAS v OHIM*, Joined cases C-581/13P & C-582/13P, paragraph 72). The opponent has submitted that the combination of the letters MQ combined with the crown device, alludes to "McQueen" and leads to the existence of the link. I disagree. The allusion created by the crown device could be one of a number of things, such as a general allusion to royalty, or to a superior quality, but I do not believe that it will be perceived as an allusion to "McQueen" even when considered in the context of the applicants' mark as a whole. It is my view that the applicants' mark will not create any link to the opponent or its marks, including MCQ, even where the earlier mark has a strong reputation and identical goods are involved. Even if I am wrong and a link were made, it would be so weak/fleeting so as to be incapable of giving rise to any of the heads of damage.

75) In light of my finding, it is not necessary for me to consider damage and detriment. I conclude that the opposition based upon section 5(3) fails in its entirety.

COSTS

76) The applicants have been wholly successful and are entitled to a contribution towards their costs. Awards of costs are governed by Annex A of Tribunal Practice Notice (TPN) 4 of 2007. As the applicants are unrepresented, at the conclusion of the evidence rounds the tribunal invited them to indicate whether they intended to make a request for an award of costs, and if so, to complete a pro-forma indicating a breakdown of their actual costs, including providing accurate estimates of the number of hours spent on a range of given activities relating to the prosecution of the opposition; it was made clear to the parties that if the pro-forma was not completed

“no costs will be awarded”. The applicants did not respond to that invitation. Consequently, I make no order as to costs.

Dated this 14th day of February 2017

A handwritten signature in black ink, appearing to be 'Mark Bryant', written in a cursive style.

**Mark Bryant
For the Registrar
The Comptroller-General**